

Application No.: 10/008235

Case No.: 55393US011

**REMARKS**

Claims 1 to 64 are pending. Claims 1 to 7 and 28 to 63 are withdrawn from consideration. Claims 8, 27, and 64 are currently amended. Claims 8 and 64 are currently amended to include an additional limitation; support for these amendments may be found in claim 1. Claim 27 is currently amended so that it now depends from the correct claim.

**§ 112 Rejection**

Claim 27 stands rejected under 35 USC § 112 as being indefinite as there is no antecedent basis in claim 19 for the recitation of first and second monomers. As stated by the Examiner, claim 27 was intended to depend from claim 26, and so claim 27 is currently amended to change claim 19 to claim 27. Applicants submit that this rejection has been overcome and respectfully request withdrawal.

**§ 103 Rejections**

Claims 8-27 and 64 stand rejected under 35 USC § 103(a) as being unpatentable over WO 99/29787. Claims 8 and 64 are currently amended to include the limitation: "wherein the reactive diluent comprises no more than about 10 weight percent of an optional alkoxyated, radiation curable monomer comprising main-chain alkoxyated functionality".

To establish a *prima facie* case of obviousness, WO 99/29787 must teach or suggest all the claim limitations. Applicants submit that WO 99/29787 does not teach that the ink compositions described therein should have this limitation. WO 99/29787 states that alkoxyated, radiation curable monomers comprising main-chain alkoxyated functionality may be used and are even preferred (emphasis added in the second excerpt):

- diacrylates of propoxyated neopentyl glycol, diethylene glycol, dipropylene glycol, tripropylene glycol, triethylene glycol and polyethylene glycols may be used (page 10, 2<sup>nd</sup> paragraph); and
- "The tri- or higher functional material may also comprise a single monomer or a mixture of monomers. Alkoxyated acrylates such as those obtained by acrylating the

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products of ethoxylating or propoxylating an initiator containing three or more active hydrogen atoms *are particularly preferred*. Examples of initiators having three or more active hydrogen atoms include glycerol, trimethylol propane, pentaerythritol and neopentyl alcohol. Examples of such alkoxylated acrylates are ethoxylated trimethylol propane triacrylates, propoxylated glyceryl triacrylates, Sartomer SR 9008 (an alkoxylated trifunctional acrylate ester) and propoxylated pentaerythritol tetraacrylates." (page 11, 1<sup>st</sup> paragraph).

WO 99/29787 does not disclose general amounts at which these materials may be used, however, the examples do. Each of the examples has an alkoxylated, radiation curable monomer comprising main-chain alkoxylated functionality: the Actilane 430 is trimethylpropane ethoxylate triacrylate, and the Actilane 422 is dipropylene glycol diacrylate. The amount used is at least about 10 weight percent.

Applicants submit that these rejections have been overcome and respectfully request withdrawal.

### Double Patenting

Claims 8-27 and 64 stand rejected under the judicially created doctrine of double patenting. Applicant respectfully defers response to this rejection given the amendments to the claims.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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